

REMARKS/ARGUMENTS

Claims 1, 3-6 and 9-17 are currently pending in the application. However, claims 10-17 are withdrawn from consideration. Based on the following remarks, Applicant respectfully requests reconsideration and allowance of the claims.

I. Rejection of Claims 1 & 3-6 Under 35 U.S.C. § 112, second paragraph

Claims 1 and 3-6 stand rejected under 35 U.S.C. § 112, second paragraph as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. In rejecting claim 1, the Examiner asserts that the “phrase ‘otherwise said set of workstations includes a pharmacist review workstation’” “renders unclear the extent to which the prescription filling process is automated.” (See pg. 2 of the Office Action) Applicant respectfully disagrees for at least the following reasons.

Applicant points out that at least pages 7-9 of the originally-filed specification describes an exemplary embodiment in which a set of workstations are determined for each prescription based on an evaluation of orders and if the prescription is fillable in an automated manner, the set of workstations excludes a pharmacist review workstation and otherwise if any of the orders are fillable in a non-automated manner, then the set of workstations includes a pharmacist review workstation that is utilized by a pharmacist to review the filled prescriptions. (See paragraph [0023] of the originally-filed specification & FIG. 3 of the application)

In view of at least the foregoing, a skilled artisan would clearly understand the recitations of claim 1 in light of the specification without requiring further explanation. Accordingly, Applicant respectfully requests the Examiner to reconsider and withdraw the § 112, second paragraph rejection of claim 1 and its dependent claims 3-6.

II. Rejection of Claim 9 Under 35 U.S.C. § 102(e)

Claim 9 stands rejected under 35 U.S.C. § 102(e) as being allegedly anticipated by Hebron et al. (U.S. Patent Appln. Publn. No. 2003/0066841; hereinafter “Hebron”).

Claim 9 recites, *inter alia*, a method of operating a prescription filling line having automated equipment and non-automated equipment for filling prescriptions, comprising evaluating a queue of orders to determine whether each prescription within each order is fillable

Appl. No.: 10/772,196
Amdt. dated April 28, 2009
Reply to Office Action of February 5, 2009

in an automated manner and where an order has been filled by automated equipment, routing each carrier for said order to a packing workstation without a review by a pharmacist. The method further comprises routing each carrier for the order to *a pharmacist workstation* before routing each carrier to the packing workstation where the order has at least *one prescription filled by non-automated equipment*.

Hebron does not teach or suggest routing any carrier for an order to *a pharmacist workstation* before routing the carrier to the packing workstation where the order has at least *one prescription filled by non-automated equipment*, as recited by claim 9. In rejecting claim 9, the Examiner relies on paragraphs [0101]-[0106] and [0109]-[0111] as well as FIG. 9 of Hebron as disclosing this feature of claim 9. In contrast to claim 9, the cited portion and indeed all of Hebron at most discloses a system 100 for automatically dispensing prescriptions to “automatically fill ... a patient’s prescription order.” (Abstract & paragraph [00401]) In this regard, Hebron explains that it is directed to automation of dispensing items to free up the pharmacist for greater patient interaction. (paragraph [0016]) Paragraphs [0109]-[0111] of Hebron at most disclose that during the process of using automated equipment to dispense prescriptions in the system 100 an alert may be generated when a vial is only partially filled. However, nowhere in Hebron is there any mention, teaching or suggestion relating to evaluating any order to determine whether a prescription is fillable by non-automated equipment as recited by claim 9. And there certainly is no teaching or suggestion in Hebron relating to routing a carrier for an order to a pharmacist workstation before routing the carrier to a packing workstation when a prescription is filled by non-automated equipment, as recited by claim 9. In contrast to claim 9, Hebron simply does not contemplate non-automated prescription filling.

Based on at least the foregoing reasons, Applicant submits that the Hebron does not teach or suggest all of the features of claim 9. Applicant therefore respectfully requests reconsideration and withdrawal of the § 102(e) rejection of independent claim 9.

III. Rejection of Claims 1 & 3-6 Under 35 U.S.C. § 103(a)

Claims 1 and 3-6 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Hebron in view of Spaulding et al. (U.S. Patent No. 5,337,919; hereinafter “Spaulding”)

Claim 1 recites, *inter alia*, a method of discriminating between orders, comprising

evaluating a queue of orders to determine whether each prescription within the order is fillable in an automated manner. The method further comprises determining a set of workstations for each prescription based on the evaluation, wherein if the prescription is fillable in an automated manner, the set of workstations *excludes a pharmacist review workstation* and otherwise the set of workstations includes a pharmacist review workstation.

The combination of Hebron and Spaulding does not teach or suggest that if a prescription is fillable in an automated manner a pharmacist review workstation is excluded from a set of workstations that were determined for a prescription and otherwise the pharmacist review workstation is included in the set of workstations, as recited by claim 1.

In rejecting claim 1, the Examiner correctly concedes that Hebron does not disclose this feature of claim 1. (See pg. 7 of the Office Action) However, the Examiner relies on Spaulding to make up for the deficiencies of Hebron. (See *id.*) Applicant disagrees and submits that Spaulding does not make up for what Hebron lacks. The Examiner relies on column 11, lines 61-97 and column 15, lines 5-25 of Spaulding for the proposition that Spaulding discloses that “if the prescription is fillable in an automated manner, said set of workstations excludes a pharmacist review workstation and otherwise said set of workstations includes a pharmacist review workstation.” (See pg. 7 of the Office Action) Contrary to the Examiner’s assertion Spaulding, alone or in combination with Hebron, at most discloses an “automatic prescription dispensing system.” (Abstract & Col. 2, lines 41-44 of Spaulding) In this regard, Spaulding explains that the automatic prescription dispensing system greatly enhances productivity and decreases the tedious aspects of filling prescriptions. (Col. 5, lines 19-22 & Col. 6, lines 12-16 of Spaulding)

The cited portion and indeed all of Spaulding, alone or in combination, at most discloses that during the process of automatically dispensing pills 12, when there is a discrepancy between a sensed weight of the pills and an expected weight of the pills an alert is provided to a display panel 31 of a pharmacist. In view of the foregoing, the cited portion and indeed all of Spaulding discloses that the automated dispensing system therein includes a pharmacist review. As such, Spaulding does not teach or suggest *excluding a pharmacist review workstation* during the process of filling a prescription in an *automated* manner, as recited by claim 1. Moreover, Spaulding, alone or in combination does not contemplate filling prescriptions in a non-automated

Appl. No.: 10/772,196
Amdt. dated April 28, 2009
Reply to Office Action of February 5, 2009

manner and including a pharmacist review workstation in a set of workstations when the prescriptions are not filled automatically, as also required by claim 1. Rather, Spaulding at most discloses an "automated prescription dispensing system". (Col., 5, lines 19-20, Col. 6, lines 14-15 & Abstract of Spaulding)

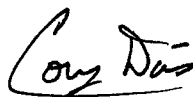
For at least the foregoing reasons, Applicant submits the combination of Hebron and Spaulding is deficient and does not teach or suggest all of the features of claim 1. Applicant therefore respectfully requests reconsideration and withdrawal of the § 103(a) rejection of claim 1 and its dependent claims 3-6.

IV. Conclusion

In view of the foregoing remarks, Applicant respectfully submits that all of the claims of the present application are in condition for allowance. It is respectfully requested that a Notice of Allowance be issued in due course. Examiner Porter is encouraged to contact Applicant's undersigned attorney to resolve any remaining issues in order to expedite examination of the present application.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Cory Davis", written in a cursive style.

Cory C. Davis
Registration No. 59,932

Appl. No.: 10/772,196
Amdt. dated April 28, 2009
Reply to Office Action of February 5, 2009

Customer No. 00826
ALSTON & BIRD LLP
Bank of America Plaza
101 South Tryon Street, Suite 4000
Charlotte, NC 28280-4000
Tel Atlanta Office (404) 881-7000
Fax Atlanta Office (404) 881-7777

ELECTRONICALLY FILED USING THE EFS-WEB ELECTRONIC FILING SYSTEM OF THE UNITED STATES PATENT & TRADEMARK OFFICE ON April 28, 2009.